

REMARKS

Claims 57 and 66 have been amended by adding new limitations for compound II. Claims 57, 58, 66, and 78 have been amended by deleting a phrase "essential" for clarification. Claims 60, 61, and 70-76 have been canceled. A support for the amendments to Claims 57 and 66 is presented, for example, in the specification at page 58, line 17. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the present application in view of the amendments and the remarks set forth below.

Discussion of Objection to Claims

Claim 57 has been objected to because of informalities. Typographic errors in general formula (1) have been corrected as the Examiner requested. Applicant respectfully requests withdrawal of the objections.

Discussion of the Claim Rejections Under 35 U.S.C. § 112

Claims 57, 58, 66, 70, 77, and 78 have been rejected under 35 U.S.C. § 112 as being indefinite.

A recitation "essential components" in Claims 57, 58, 66, and 78 has been found unclear. The recitation has been deleted from Claims 57 and 58. A phrase "essential" has been deleted from Claims 66 and 78.

Claim 70 has been canceled in view of the coverage of the rest of the claims. This rejection is moot.

As for Claim 77, a recitation "a one-component curable composition" in Claim 77 has been found to conflict with a recitation "the curable composition comprises two components" in Claim 57. As stated in the present specification at page 57, lines 10-13, "a one-component curable composition" is a composition which does not need another component to be cured. Accordingly, the recitations do not conflict each other. Applicant respectfully requests withdrawal of the rejections.

Discussion of Claim Rejections Under 35 U.S.C. § 102(b)

Claims 57-70, 76,-82 and 83-85 have been rejected under 35 U.S.C. § 102(b), as being anticipated by Fujita et al. (WO 00/20498: U.S Publication No. 2004/0029990 is used for English equivalent). Applicant respectfully submits that pending claims are allowable over Fujita et al., as discussed below.

Standard of Anticipation

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. “*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1375, 1376 (Fed. Cir. 2001)

Discussion of Patentability of Independent Claim 57

As amended herein, Claim 57 recites among other things, “vinyl polymer (I) has a methyl acrylate or methyl methacrylate as a constituent unit”, and also recites “amine compound” Although, Fujita et al. disclose a use of methyl (meth)acrylate, it is listed as one of very long list of possible monomers. This term is sometime used to refer to methyl acrylate or methyl methacrylate. However, neither the methyl acrylate nor methyl methacrylate are used in the embodiments of Fujita et al. Moreover, the specific combination of these compound with an amine compound is nowhere disclosed in Fujita et al. In fact, the amine compound is described as an optional component. (Paragraph [0224] – [0228]) Accordingly, Fujita et al do not teach the recited combination of the methyl acrylate or methyl methacrylate with an amine compound.

As amended herein, Claim 57 recites among other things, an alternative that it “further comprises a compound (II) which is selected from the group consisting of dimethyl malonate, dimethyl succinate, dimethyl glutarate, dimethyl adipate, dimethyl sebacate, methyl acetate, methyl propionate, methyl butyrate, methyl valerate, methyl caprylate, methyl caprate, methyl laurate, methyl myristate, methyl palmitate, methyl stearate, methyl oleate, methyl ricinoleate, and coconut fatty acid methyl ester” while Fujita et al. teach a use of e butyl oleate, dioctyl adipate. isodecyl succinate, dioctyl sabacate and dobuthyl sebacate. (Paragraph [0242]) Thus, as the Examiner acknowledged, the cited reference does not teach a use of methyl esters either expressly or inherently. Therefore, Applicant respectfully submits that Claim 57 is not anticipated by the cited reference and Claims 1 is allowable over the prior art of record.

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Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from base Claim 57, and further define additional technical features of the present invention. In view of the patentability of Claim 57, and in further view of the additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e)

Claims 57-70, 76,-82 and 83-85 have been rejected under 35 U.S.C. § 102(e), as being anticipated by Fujita et al. (U.S. Patent No. 7,388,038). Since Patent '038 is division of U.S. Publication No. 2004/0029990, their disclosures are essentially identical to each other. Consequently the same argument as above is applicable here. Moreover, because of the PCT application was published in a language other than English, the international filing date can not be used to establish an effective date under 102(e). Consequently, the US patent is only effective as prior art as of the August 7, 2003 filing date of its patent. This date is after the priority date claimed by the present application. Applicant respectfully requests withdrawal of the rejection.

In addition to the above, the undersigned hereby verifies that the subject matter disclosed in Fujita et al. and the claimed invention were, at the time the claimed invention was made, owned by the same assignee of record, Kaneka Corporation or subject to an obligation of assignment to the same assignee of record.

Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claims 71-72 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fujita et al. Claims 71-72 have been canceled in view of coverage of the rest of the claims. This rejection is moot.

Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claims 73-76 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fujita et al. in view of Inoue et al. (U.S. Patent No. 6,255,392)

Claims 73-76 have been canceled in view of coverage of the rest of the claims. This rejection is moot.

Discussion of the Claim Rejections Under 35 U.S.C. § 103

Claim 82 has been rejected under 35 U.S.C. § 103 as being unpatentable over Fujita et al. in view of Ueda et al. (U.S. Patent No. 5,910,555). Applicant respectfully submits that pending claims are allowable over Fujita et al. and Ueda et al., as discussed below.

Ueda et al. is silent about both alternatives in the claims, i.e. the use of the methyl acrylate or methyl methacrylate, or the recited methyl esters, in combination with the amine as recited in Claims 57. Nothing in either reference would suggest the specific combination as claimed. Accordingly, the cited references would not match with the present claimed invention, even if combined, and will not lead to a prima facie showing of obviousness.

Moreover, both of the recited alternative features provide an unexpected advantage which further evidence the non-obviousness of the claimed invention. In particular, as shown in test results in Tables 1-3, Examples 3-5, which are prepared using the methyl acrylate or methyl methacrylate, indicate excellent results in skinning time after storage and tensile physical properties over Comparative Examples 3 and 4, which are prepared using butyl acrylate.

Also in Tables 4 and 5, Example 22 & 23, and Comparative Examples 11, 12, and 13 show that a use of the recited methyl esters provides a huge impact on the curing time. Nothing in the prior art would lead one having ordinary skill in the art to expect these results with regards to either alternative. Therefore, even if prima facie case of obviousness were established, this unexpected result would rebut any such case. Thus, Claim 57 is patentable over the combination of the cited reference. Claim 82 depends from Claim 57, and further defines additional technical features of the present invention. In view of the patentability of Claim 57, and in further view of the additional technical features, Applicants respectfully submit that Claim 82 is patentable over the prior art.

Discussion of Double Patenting

Claims 57-61, 63-69, 71-74, and 75-78 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-9 of U.S. Patent No. 7,388,038 to Fujita et al. As set forth above, the claims as amended herein, are patentably distinct from the entire reference claims. Applicant respectfully requests the rejection based on non-statutory double patenting.

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CONCLUSION

In the light of the applicant's amendments to the claims and the following Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

No Disclaimers or Disavowals


Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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